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21003	7590	03/03/2009		
BAKER BOTTS L.L.P. 30 ROCKEFELLER PLAZA 44TH FLOOR NEW YORK, NY 10112-4498			EXAMINER RUDY, ANDREW J	
			ART UNIT 3687	PAPER NUMBER
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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* VIVEKA LINDE and MATS LINDE
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11 Appeal 2008-4097
12 Application 10/006,600
13 Technology Center 3600
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16 Decided:¹ February 27, 2009
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19 *Before* MURRIEL E. CRAWFORD, DAVID B. WALKER, and BIBHU R.
20 MOHANTY, *Administrative Patent Judges*.

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22 CRAWFORD, *Administrative Patent Judge*.
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24 DECISION ON APPEAL

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26 STATEMENT OF THE CASE

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Appellants appeal under 35 U.S.C. § 134 (2002) from a non-final rejection of claims 1 to 3. Claims 4 to 7 have been withdrawn from consideration. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellants invented a method of determining the post-launch performance of a product on a market (Specification 1).

Claim 1 under appeal reads as follows:

1. A method for determining the post-launch performance of a product on a market, comprising:
storing, in a database, collected first data related to at least one key success factor associated with at least a market performance which is related to said product;
storing, in a database, collected second data related to unmet product needs on said market;
storing, in a database, collected third data related to a propensity of a decision-maker to choose said product;
linking a computer to said databases; and
using a simulation model on said computer to calculate a future market share of said product based on said collected first, second, and third data, thereby determining said post-launch performance on said market.

The Examiner rejected claims 1 to 3 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Appellant regards as the invention. The Examiner is of the opinion that the phrase “related to” in lines 3, 5 and 7 of claim 1 is not clear.

The Examiner rejected claims 1 to 3 under 35 U.S.C. § 103(a) as being unpatentable over Delurgio.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Delurgio et al. US 7,092,896 B2 Aug. 15, 2006

ISSUES

Have the Appellants shown that the Examiner erred in holding that the phrase “related to” in lines 3, 5 and 7 of claim 1 is unclear?

Have the Appellants shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a) as being unpatentable over Delurgio, because Delurgio does not disclose or suggest using a simulation model on a computer to calculate future market share of a product and thereby determine the post-launch performance on the market from data related to one key success factor, unmet product needs on the market, and a propensity of a decision maker to choose the product?

FINDINGS OF FACT

Delurgio discloses a promotion optimization method for a group of products within a store or group of stores (col. 5, ll. 35 to 38). Delurgio discloses that three main elements must be balanced in order to produce an optimized plan (col. 5, ll. 53 to 55). The three elements are merchandising events 101, supplier offers 102 and rules and objectives 103 (col. 5, ll. 55 to 57). Exemplary types of merchandising events 101 are featured displays, advertising and variously types of temporary price reductions such as coupons (col. 5, ll. 61 to 65). Rules and objectives include timing and frequency of promotions, objectives of the promotion such as maximizing volume, revenue and profit (col. 6, ll. 21 to 26). Delurgio includes an optimization engine 234 connected to a results processor 233 which receives data from a customer data base 238 (Figure 2). The customer data base 238 includes customer data sets 239 corresponding to a plurality of customers

(col. 7, ll. 14 to 15). The customer data sets include point of sale data from files on the customer computers 210 and supplier offers (col. 7, ll. 16 to 22). Delurgio does not disclose storing data related to at least one key success factor associated with at least a market performance related to a product. Delurgio does not disclose storing data related to unmet product needs in the market. Therefore, it follows that Delurgio does not disclose a simulation model that calculates a future market share based on the one key success factor, unmet product need and propensity of a decision maker to choose the product.

PRINCIPLES OF LAW

Indefiniteness

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. *In re Johnson*, 558 F.2d 1008, 1015 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. *Id.*

The Examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of

1 expression and the aptness of terms is permitted even though the claim
2 language is not as precise as the examiner might desire. If the scope of the
3 invention sought to be patented cannot be determined from the language of
4 the claims with a reasonable degree of certainty, a rejection of the claims
5 under 35 U.S.C. § 112, second paragraph, is appropriate.

6 Furthermore, Appellants may use functional language, alternative
7 expressions, negative limitations, or any style of expression or format of
8 claim which makes clear the boundaries of the subject matter for which
9 protection is sought. As noted by the Court in *In re Swinehart*, 439 F.2d
10 2106 (CCPA 1971), a claim may not be rejected solely because of the type
11 of language used to define the subject matter for which patent protection is
12 sought.

13 Obviousness

14 An invention is not patentable under 35 U.S.C. § 103 if it is obvious.
15 *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1745-46 (2007). The facts
16 underlying an obviousness inquiry include: Under § 103, the scope and
17 content of the prior art are to be determined; differences between the prior
18 art and the claims at issue are to be ascertained; and the level of ordinary
19 skill in the pertinent art resolved. Against this background the obviousness
20 or nonobviousness of the subject matter is determined. Such secondary
21 considerations as commercial success, long felt but unsolved needs, failure
22 of others, etc., might be utilized to give light to the circumstances
23 surrounding the origin of the subject matter sought to be patented. *Graham*
24 *v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

ANALYSIS

We will not sustain the Examiner's rejection of claims 1 to 3 under 35 U.S.C. § 112, second paragraph. We agree with Appellants that the phrase "related to" following the noun "data" is a descriptor of the type of data claimed. Pages 7 and 9 of the Specification explains that information regarding success factors, unmet product need and propensity of a decision maker to choose the product is crucial for the determination of the future sales of the product. As such, the phrase meets the threshold requirements of 35 U.S.C. § 112, second paragraph for clarity and precision.

We will not sustain the Examiner's rejection of claims 1 to 3 under 35 U.S.C. § 103(a) because the Examiner has not established that Delurgio discloses or suggests the subject matter recited in claim 1 from which claims 2 and 3 depend. Specifically, Delurgio does not disclose the step of using a simulation model to calculate future market share based on data related to a key success factor and unmet product needs as is required by claim 1. While Delurgio does disclose an optimization engine that utilizes data to predict sales and market share, the Examiner has not directed our attention to any disclosure or suggestion of the storage or analysis of success factors and unmet product needs.

DECISION

The decision of the Examiner is reversed.

REVERSED

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